

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/559,972

Applicant: Plum et al.

Filed: April 7, 2006

TC/AU: 3634

Examiner: Strimbu, Gregory J.

Docket No.: 245545 (Client Reference No. 6NP/FF40039US)

Customer No.: 23460

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REPLY TO RESTRICTION REQUIREMENT AND
REQUEST FOR RECONSIDERATION**

Dear Sir:

In response to the restriction requirement of the Office Action dated June 23, 2008, in addition to claims 1-7, 23, 26, 30, 31 and 34, which have been deemed generic, Applicants hereby elect the invention of Group XIII, deemed to include claims 8, 17-21, 24 and figures 18a, 18b and 18c directed to a sealing strip for a closure member.

REMARKS

M.P.E.P. § 803 (I) requires that the following two criteria must be satisfied in order to support a restriction requirement: “(A) The inventions must be independent or distinct as claimed; and (B) There would be a serious burden on the examiner if restriction is not required.” (Citations omitted.) Unless both of these criterion are met, a restriction requirement is not permitted.

The entire claim set must be examined if the search and examination can be done without serious burden regardless of whether the claim set includes independent or distinct inventions. M.P.E.P. § 803 states that even if the claims include groups of patentably distinct inventions, a restriction requirement should not be made if a search of all of the claims can be made without a serious burden. Nothing in the record evidences a serious burden results from examining all of the claims presented in this application. The Office Action does not assert that such a burden exist, and, for that reason alone, the restriction requirement should be dropped. Moreover, the Office Action does not so much as identify the classes and subclasses in which the proposed restriction groups would allegedly be classified.

In contrast, by enforcing the restriction requirement, the applicants are seriously burdened by the added expense of separately pursuing the withdrawn claims in additional applications, as well as the added expense of issuing, and maintaining more than one application and, ultimately, more than one patent. Further, enforcement of the restriction requirement results in undue burden and excess paperwork for the Office inasmuch as two applications, presumably two patents, and two sets of maintenance fees must be processed by the Office. Further, the Office Action incorrectly cites standards under the Patent Cooperative Treaty, as opposed to the applicable United States standards. Applying the appropriate standards under U.S. law, a restriction requirement is inappropriate.


Accordingly, Applicants traverse the requirement insofar as the pending claims may be readily searched in a single search without undue burden on the Office, and disposition of all of the disclosed embodiments of this application in a single examination would be more economical for both the inventors and the Office. Applicants additionally respectfully request reconsideration of the restriction requirement.

CONCLUSION

In view of the foregoing, applicants respectfully request that the requirement be withdrawn. The claim groups are not properly the subject of a restriction requirement in that they can clearly be examined together without serious burden to the Office. Indeed, enforcement of the restriction requirement would result in undue burden and expense not only to the applicant, but also to the Office in the prosecution and maintenance of two files.

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call Pamela J. Ruschau, Registration No. 34,242, at the telephone number shown below.

Respectfully submitted,

A handwritten signature in cursive script, reading "Pamela J. Ruschau", is written over a horizontal line.

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Date: July 23, 2008